

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

DEMAND FOR JURY TRIAL

1 Inc., which maintains a corporate office in San Francisco, California. The Defendant
 2 Domain was formerly owned by Plaintiff and was used to refer internet users to Plaintiff's
 3 website and business in association with corresponding DENSO trademarks. Those
 4 trademarks are registered with the U.S. Patent and Trademark Office ("USPTO") and
 5 elsewhere internationally.

6 4. Doe Defendants include the current registrants of the Defendant Domain who
 7 are unknown, and have registered and used the Defendant Domain in bad faith to infringe
 8 upon Plaintiff's trademarks. Plaintiff is presently unable to locate the Doe Defendants who
 9 are the unknown registrants and/or users of the Defendant Domains, as they are registered
 10 via a "WHOIS privacy" service located in Russia. Plaintiff expects that further investigation
 11 may reveal the identities of Doe Defendants.

12 NATURE OF THE CASE

13 5. Plaintiff brings this *in rem* action under the Anti-cybersquatting Consumer
 14 Protection Act of 1999, 15 U.S.C. § 1125(d) ("ACPA"), to recover the Defendant Domain,
 15 which has been cybersquatted by Doe Defendants for their commercial gain.

16 6. In 2003, the Defendant Domain was the subject of an administrative
 17 proceeding under ICANN's Uniform Dispute Resolution Policy ("UDRP"). The expert
 18 arbitrator found that registrants were using the Defendant Domain in bad faith and ordered
 19 that it be transferred to Complainant, herein Plaintiff.

20 7. Following the UDRP proceeding, both the registrant and registrar refused to
 21 transfer the Defendant Domain to Plaintiff, in violation of the UDRP. Instead, they engaged
 22 in a number of bad faith ownership and registration transfers to prevent Plaintiff from
 23 obtaining possession of the Defendant Domain.

24 8. The ACPA explicitly allows a trademark owner to proceed *in rem* against a
 25 domain name when the domain name registrant has a bad faith intent to profit from a mark,
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1 and the registrant cannot be found through due diligence or the Court lacks personal
2 jurisdiction over the registrant.

3 9. Plaintiff was injured when Defendant Domain was registered by Doe
4 Defendants, who then used Defendant Domain to direct internet users to a website where
5 men could arrange sexual encounters with foreign women. Doe Defendants continue to
6 injure Plaintiff by falsely suggesting that the website connected via the Defendant Domain is
7 connected with Plaintiff. This content reflects poorly on Plaintiff who owns trademarks
8 corresponding to the Defendant Domain and does business under the DENSO name. Many
9 internet users would reasonably believe that the Defendant Domain is controlled by Plaintiff,
10 and would seek Plaintiff's products and information about Plaintiff via use of the Defendant
11 Domain – only instead to be referred to a website controlled by Doe Defendants.

12 10. Plaintiff is further injured by Doe Defendants' bad faith refusal to transfer the
13 Defendant Domain to Plaintiff, even after transfer was mandated via administrative UDRP
14 order in 2003, and again by the Supreme Court of Russia in 2008.

15 11. Plaintiff files this action so that the domain name registry, Verisign, Inc., will
16 lock Defendant Domain so it cannot be further transferred during the pendency of this
17 action, and to request this honorable Court to order the transfer of the Defendant Domain to
18 Plaintiff per the ACPA.

19 **JURISDICTION AND VENUE**

20 12. This Court has jurisdiction over the subject matter of this action pursuant to
21 Section 39 of the Trademark Act of 1946, 15 U.S.C. §§ 1121 and 28 U.S.C. §§ 1331 and
22 1338. This court has *in rem* jurisdiction over Defendant Domain pursuant to § 43(d)(2)(A)
23 of the Trademark Act of 1946, 15 U.S.C. §125(d)(2)(A). Defendant Domain is currently
24 registered by persons or entities purportedly located in foreign countries, hiding behind a
25 domain name privacy service.
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13. Venue is proper in this judicial district pursuant to § 43(d)(2)(C) of the Trademark Act of 1946, 15 U.S.C. § 1125 (d)(2)(C), in that a domain is deemed to have situs in the judicial district where the domain name registry is located. VeriSign, Inc., the domain name registry for all of the Defendant Domains, maintains one of its two United States corporate offices in this judicial district, at 185 Berry Street, Wharfside Building, Suite 1000, San Francisco, CA 94107.

FACTS

14. Plaintiff is a leading supplier of advanced automotive technology, systems and components for all the world's major automakers, and operates in more than 30 countries and regions with approximately 130,000 employees.

15. Plaintiff has numerous USPTO trademark registrations and a pending application corresponding to the Defendant Domain:

- a. DENSO, registration no. 2409698, registered on December 5, 2000, in International Classes 007, 009, 011, 012 and 037.
- b. DENSO, registration no. 3058385, registered on February 14, 2006, in International Classes 007, 009, 011, 012 and 037.
- c. DENSO, registration no. 3909641, registered on January 25, 2011, in International Classes 001, 003, 004, 005, 006, 007, 008, 010, 011, 012, 014, 016 and 017.
- d. DENSO, registration no. 3963936, registered on May 24, 2011, in International Classes 035, 036, 037, 038, 039, 041, 042 and 045.
- e. DENSO, registration no. 4344605, registered on June 4, 2013, in International Classes 001, 006, 007, 014, 017, 035, 036, 037, 038, 040, 041, 042 and 045.

1 f. DENSO, application no. 85538472, applied for on February 9, 2012,
2 in International Classes 001, 007, 009, 011, 012, 028, 035 and 037.

3 16. In August 1996, a subordinate company of Plaintiff (the “subordinate
4 company”) received the Defendant Domain as a transfer from the previous owner of the
5 Defendant Domain. At the time, Defendant Domain was registered through Network
6 Solutions, Inc. (“NSI”).

7 17. In February 1998, the subordinate company renewed the Defendant
8 Domain’s registration through March 6, 2000. However, the Whois information still listed
9 the previous owner as the registrant of Defendant Domain, with an individual at the
10 subordinate company listed as the administrative and billing contact.

11 18. Between December 1999 and February 2000, NSI attempted to notify
12 company about the upcoming expiration of the registration for the Defendant Domain. The
13 individual listed as the administrative and billing contact left the subordinate company prior
14 to receiving the notices. The subordinate company was therefore unaware of the notices and
15 never responded.

16 19. On March 6, 2000, Plaintiff’s registration of the Defendant Domain lapsed.

17 20. On March 13, 2000, a Russian company registered the Defendant Domain.
18 Subsequently, the company used the Defendant Domain to direct internet users to a website
19 called “Foreign Affairs” that allowed American men to arrange sexual encounters with
20 foreign women.

21 21. Between January 2001 and March 2001 Doe Defendants engaged in a
22 number of bad faith ownership transfers, listing three different registrants at two different
23 addresses, making it difficult for Plaintiff to contact the registrant.

24 22. On August 16, 2001, Plaintiff sent the then-listed registrant a letter requesting
25 that the registrant transfer the domain to Plaintiff in exchange for any costs incurred by
26 registrant in acquiring Defendant Domain.

1 23. On September 21, 2001, the registrant at the time, Denso Ltd., replied that
2 they were still formulating their position with regard to the Defendant Domain.

3 24. On October 5, 2001, Plaintiff again emailed the registrant requesting an
4 answer to their initial offer. Registrant responded that same day, but refused Plaintiff's
5 offer.

6 25. Subsequently, on June 23, 2003, Plaintiff filed a UDRP administrative action
7 in an effort to recover the Defendant Domain from registrant, WIPO Case No. 2003-0482.

8 26. On November 3, 2003, the expert arbitration panel from the World
9 Intellectual Property Organization ("WIPO") released its decision finding that the registrant
10 registered and used the Defendant Domain in bad faith, recognizing Plaintiff's rights in
11 Defendant Domain, and ordering the transfer of Defendant Domain to Plaintiff.

12 27. Following the decision, both the registrant and registrar of Defendant Domain
13 refused to transfer Defendant Domain to Plaintiff.

14 28. Subsequently, the Registrant filed a claim with the Arbitrazh Court of the
15 City of St. Petersburg and the Leningrad Region in Russia disputing Plaintiff's rights to the
16 Defendant Domain. After numerous appeals, Plaintiff ultimately prevailed in the Russian
17 Supreme Court via a published decision dated November 11, 2008. Again, the registrant
18 and registrar of Defendant Domain refused to transfer the Defendant Domain to Plaintiff.

19 29. Currently, the Defendant Domain resolves to a website used for Doe
20 Defendants' sole commercial purposes, and in a manner that internet users, customers and
21 prospective customers of Plaintiff are likely to believe this website is somehow affiliated
22 with Plaintiff.

23 30. Both the registrant and registrar of the Defendant Domain have continually
24 refused to transfer Defendant Domain to Plaintiff's control, despite orders by WIPO and the
25 Russian Supreme Court recognizing Plaintiff's ownership rights in Defendant Domain.

1 Instead they have made numerous bad faith transfers of the Defendant Domain to prevent
2 Plaintiff from regaining control of the Defendant Domain despite diligent attempts to do so.

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6 **CLAIMS FOR RELIEF**

7 **COUNT I: CYBERPIRACY UNDER 43(D) OF THE LANHAM ACT**

8 **15 U.S.C. § 1125(d)(1)(A)**

9 31. Plaintiffs incorporate each of the foregoing paragraphs as if fully set forth
10 herein.

11 32. The public has come to expect that a company's corporate or product website
12 can be found at a domain name that consists of or includes that company's name or
13 trademark or variations thereof. A domain name incorporating a corporate name or
14 trademark is therefore a valuable corporate asset that allows potential customers and other
15 Internet users to obtain information about that owner and its products. For this same reason,
16 a domain name misappropriating the corporate name or trademark of another entity creates
17 the potential for damaging consumer confusion because an Internet user may reasonably
18 assume that the domain name is sponsored by, affiliated with, or somehow approved by the
19 owner of the corporate name or trademark. Such domain names also dilute the
20 distinctiveness of a trademark, and can also tarnish the mark if used with unsavory content
21 or inferior goods or services.

22 33. Through many years of use in U.S. and international commerce, Internet
23 users have come to associate the Defendant Domain with Plaintiff and its products. Plaintiff
24 also owns numerous USPTO trademark registrations and one application corresponding to
25 the Defendant Domain. Therefore, Plaintiff has strong trademark rights in the Defendant
26 Domain.

1 34. Both WIPO and the Russian Supreme Court have recognized Plaintiff's
2 superior rights in Defendant Domain and have ordered the transfer of Defendant Domain to
3 Plaintiff's control.

4 35. The registration, use, and/or trafficking in the corresponding Defendant
5 Domains violates the rights of Plaintiff in their trademarks under 15 U.S.C. § 1125 (d) (1)
6 (A).

7 36. The Defendant Domain is identical to Plaintiff's distinctive and famous
8 trademark, adding only the ubiquitous '.com' TLD to indicate the commercial nature of the
9 domain name's use. The Defendant Domain has been and still is used to create a likelihood
10 of confusion among Internet users seeking Plaintiff's products and services.

11 37. The Doe Defendants acted with a bad faith intent to profit from Plaintiffs'
12 trademarks and the good will associated therewith, within the meaning of Section
13 43(d)(1)(A)(i) of the Lanham Act.

14 38. The Defendant Domain is a cybersquatted, identical version of Plaintiff's
15 trademark, causing significant injury and damage to Plaintiff and its business.

16 39. The Plaintiffs' injury can be alleviated by the court-ordered return of the
17 Defendant Domain to Plaintiff's rightful ownership and possession.

18 40. Plaintiffs' further investigation may also reveal Doe Defendants who should
19 be held liable for damages to further redress Plaintiffs' injury, including statutory damages
20 under the ACPA of up to \$100,000 per cybersquatted domain name.

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22 **COUNT II: CONVERSION**

23 41. Plaintiffs incorporate each of the foregoing paragraphs as if fully set forth
24 herein.

25 42. Plaintiff is the rightful owner of the Defendant Domain. Both WIPO and the
26 Russian Supreme Court have recognized Plaintiff's superior rights in the Defendant Domain

1 and ordered that the Defendant Domain be transferred to Plaintiff's control. Still, Doe
2 Defendants, including without limitation the registrant and registrar of the Defendant
3 Domain, refuse to transfer Defendant Domain to Plaintiff's control.

4 43. This conversion of Plaintiff's valuable domain name property has caused
5 damage to Plaintiffs, and is likely to continue to cause damage to Plaintiffs until this
6 honorable Court orders the transfer of the Defendant Domain to Plaintiff.

7 **COUNT III: COMMON LAW UNFAIR COMPETITION**

8 44. Plaintiff incorporates each of the foregoing paragraphs as if fully set forth
9 herein.

10 45. Doe Defendants have ignored the results of administrative proceedings, and
11 of Russian judicial proceedings, each culminating with an order of transfer of the Defendant
12 Domain to Plaintiff.

13 46. Doe Defendants' wrongful and baseless acts have prevented Plaintiff from
14 recovering title to the Defendant Domain, and from utilizing that valuable property in
15 Plaintiff's business.

16 47. As a result of Doe Defendants' past and continued wrongful acts, Plaintiff
17 has incurred damages in an amount to be proved at trial, including compensation for
18 Plaintiff's time, effort, costs and attorneys' fees incurred in this matter and in the prior
19 administrative and judicial proceedings relating to the Defendant Domain.

20 **COUNT IV: UNFAIR COMPETITION**

21 **CAL. BUS. & PROF. CODE SEC. 17200, *et seq.***

22 48. Plaintiff incorporates each of the foregoing paragraphs as if fully set forth
23 herein.

1 49. Doe Defendants' wrongful acts, as described in this Complaint, are unlawful,
2 unfair and fraudulent, and cause damage to Plaintiff and injure its business, in violation of
3 section 17200 *et seq* of the California Business and Professions Code.

4 50. As a result of Doe Defendants' past and continued wrongful acts, Plaintiff
5 has incurred damages in an amount to be proved at trial, including compensation for
6 Plaintiff's time, effort, costs and attorneys' fees incurred in this matter and in the prior
7 administrative and judicial proceedings relating to the Defendant Domain.

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9 **DEMAND FOR JURY TRIAL**

10 Plaintiff respectfully requests that all issues in this case be decided by a jury.

11
12 WHEREFORE, Plaintiffs respectfully request that this Court enter judgment in their
13 favor:

14 A. Requiring the domain name registry Verisign and the current domain name
15 registrar for the Defendant Domain to transfer the registration of Defendant Domain
16 to Plaintiff; and,

17 B. Awarding damages, attorneys' fees, costs, and such other relief as this Court
18 may deem appropriate.

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20 RESPECTFULLY SUBMITTED,

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22
23 DATED: March 6, 2014

By: 

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COMPLAINT
Case No. 14-cv-01050

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